

REMARKS/ARGUMENTS

Claims 1-5, 7-15, 17-27 and 29 are pending in the present application. Claims 1, 7-11, 17-23, 26, 27 and 29 have been amended, and Claims 6, 16, 28 and 30-34 have been cancelled, herewith. Reconsideration of the pending claims is respectfully requested.

I. Objection to Information Disclosure Statement

The Examiner objected to the previously submitted information disclosure statement, as one item listed did not appear to be a valid US PG PUB and another item was listed twice. Applicants are submitting herewith another information disclosure statement that corrects these errors.

Therefore, the objection to the information disclosure statement has been overcome.

II. Objection to Claims

Claim 33 was objected to because of an informality. Applicants have cancelled such claim herewith, without prejudice or disclaimer. Therefore, the objection to the claim has been overcome.

III. 35 U.S.C. § 112, Second Paragraph

Claims 6, 16 and 28 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicants regard as the invention. Applicants have cancelled Claims 6, 16 and 28 herewith, without prejudice or disclaimer.

Therefore the rejection of Claims 6, 16 and 28 under 35 U.S.C. § 112, second paragraph has been overcome.

IV. 35 U.S.C. § 101

Claims 1-34 stand rejected under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. This rejection is respectfully traversed.

With respect to Claims 1 (and dependent Claims 2-6), 10 (and dependent Claims 11-16), 29 (and dependent Claims 30-33) and 34, the Examiner states that such claims are non-statutory as being directed to a signal, which is a form of energy. Applicants have amended Claims 1, 10 and 29 in accordance with *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035, which states that a claimed computer readable medium encoded with a computer program is a computer element which defines structural and functional inter-relationships between the computer program and the rest of the computer which permits the computer program's functionality to be realized, and is thus statutory. With respect to Claims 30-34, Applicants have cancelled such claims herewith, without prejudice or disclaimer.

With respect to Claims 7-9 and 17-22, the Examiner states that such claims are directed towards software per se that lacks the necessary physical articles or objects to constitute a machine or manufacture within the meaning of 35 USC 101. Applicants have amended such claims to overcome such rejection.

No reason was given as to why Claims 23-28 are non-statutory. Applicants urge that such claims are allowable under 35 U.S.C. § 101 as being directed to a computer implemented method, which is a type of process¹.

Therefore the rejection of Claims 1-34 under 35 U.S.C. § 101 has been overcome.

V. 35 U.S.C. § 103, Obviousness

Claims 1-3, 7, 8, 10-13, 17-19, 21-25, 29 and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brisson (U.S. Patent No. 5,678,052) and further in view of Collier et al. (U.S. Patent No. 5,815,152). This rejection is respectfully traversed.

With respect to Claim 1, such claim recites “computer readable program code means for storing and maintaining a set of features identifiable in graphical business process representations, each feature in the set of features having an associated pattern mapping defined relative to structural text-based representations”, “computer readable program code means for identifying portions of an initial graphical representation as matching features in the set of features”, and “computer readable program code means for generating structural textbased representations of the identified portions of the initial graphical representation by applying the pattern mappings associated with the matching features to the identified portions of the graph-based representation”. As can be seen, per the features of Claim 1, there are a set of features identifiable in graphical business process representations – and each of these features has an associated pattern mapping defined relative to structural text-based representations. As to the use of such pattern mapping, portions of an initial graphical representation are identified as matching features in the set of features. These identified portions are then used to generate structural textbased representations thereof by applying the pattern mappings (that are associated with the matching features) to such identified portions. In rejecting these aspects of Claim 1, the Examiner asserts that:

“Brisson discloses using pattern mappings to create the RR diagram (see figure 3).”

¹ §101. Inventions patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title [35 USC § §1 et seq.]. (emphasis added by Applicants)

The Examiner makes no assertion or allegation that any of the cited references teach or otherwise suggest “a set of features”, or a set of features that are identifiable in graphical representations, or that the pattern mapping is defined relative to structural text-based representations, as claimed. Thus, it is urged that the Examiner has failed to properly establish a prima facie showing of obviousness with such generalized, cursory statement the pattern mappings are *used to create the RR diagram*², as such generalized assertion does not establish a teaching or suggestion with respect to the particular detailed features recited in such claim. Thus, it is shown that Claim 1 has been erroneously rejected due to such failure to properly establish a prima facie showing of obviousness.

Further with respect to Claim 1, the Examiner states that while Brisson does not directly disclose creating a BNF from a RR diagram,

“it is inherent in Brisson to convert a RR diagram into a BNF using pattern mapping”

Applicants urge that such inherency assertion is legally deficient. “To establish inherency,” the Federal Circuit recently stated, “the extrinsic evidence `must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *In re Robertson*, 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999); see also *Continental Can Co. U.S.A., Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268 [20 USPQ2d 1746] (Fed. Cir. 1991). Such inherency may not be established by “probabilities or possibilities.” *Continental Can*, 948 F.2d at 1269 (quoting *In re Oelrich*, 666 F.2d 578, 581 [212 USPQ 323] (C.C.P.A. 1981)). There is no extrinsic evidence of record that makes it clear that the cited reference teaches any ability to convert a graphical representation into a textual-based representation. Importantly, the cited Brisson reference teaches exactly the opposite capability of converting a text-based representation into a graphical

² In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.* To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. See also, *In re Royka*, 490 F.2d 580 (C.C.P.A. 1974). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

representation (col. 3, lines 45-46; col. 4, lines 52-55). Thus, the Examiner's inherency assertion is made without proper extrinsic evidence support as required by the case law described above.

Still further with respect to the Examiner's inherency assertion, in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA 1976); *Hansgird v. Kemmer*, 102 F.2d 212, 40 USPQ 665 (CCPA 1939) (emphasis added by Applicants). The Examiner has provided *no* basis in fact or technical reasoning to reasonably support a determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Instead, the Examiner merely conclusively states that the missing claimed features are inherent. Thus, it is further shown that Claim 1 has been erroneously rejected due this further inherency assertion deficiency.

By using the pattern mapping in conjunction with the set of features that are identified in a graphical business process representation, and in addition identifying portions of an initial structural text-based representation of a business process as corresponding to pattern mappings associated with features in the same set of features, it is possible to obtain both a consistent and repeatable conversion from graphical representations to text-based representations as well as re-converting such text-based representations to equivalent graphical representations. None of the cited references teach or suggest such claimed features or the resulting advantages provided thereby of two-way conversion of graphical-to-text and text-to-graphical representations of business processes.

Applicants traverse the rejection of Claims 2 and 3 for reasons given above with respect to Claim 1 (of which Claims 2 and 3 depend upon).

Applicants traverse the rejection of Claim 7 (and dependent Claim 8) for similar reasons to those given above with respect to Claim 1.

Applicants traverse the rejection of Claim 10 (and dependent Claims 11-13) for similar reasons to those given above with respect to Claim 1.

Applicants traverse the rejection of Claim 17 (and dependent Claims 18-19) for similar reasons to those given above with respect to Claim 1.

Applicants traverse the rejection of Claim 21 (and dependent Claim 22) for similar reasons to those given above with respect to Claim 1.

Applicants traverse the rejection of Claim 23 (and dependent Claims 24-25 and 29) for similar reasons to those given above with respect to Claim 1.

Therefore, the rejection of Claims 1-3, 7, 8, 10-13, 17-19, 21-25, 29 and 30 under 35 U.S.C. § 103 has been overcome.

VI. 35 U.S.C. § 103, Obviousness

Claims 4-6, 9, 14-16, 20 and 26-28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brisson (U.S. Patent No. 5,678,052) and Collier et al. (U.S. Patent No. 5,815,152) as applied to Claim 3, and in further view of Nemer (U.S. Publication No. 2003/0110446). This rejection is respectfully traversed.

Applicants traverse the rejection of Claims 4-6, 9, 14-16, 20 and 26-28 for substantially the same reasons as those given above with respect to Claim 1, and the newly cited Nemer reference does not overcome the missing claimed features and inherency deficiencies identified above with respect to Claim 1.

Therefore, the rejection of Claims 4-6, 9, 14-16, 20 and 26-28 under 35 U.S.C. § 103 has been overcome.

VII. 35 U.S.C. § 103, Obviousness

Claims 31-33 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brisson (U.S. Patent No. 5,678,052) and Collier et al. (U.S. Patent No. 5,815,152) as applied to Claim 9, and in further view of Official Notice. This rejection is respectfully traversed.

Applicants have cancelled Claims 31-33 herewith, without prejudice or disclaimer.

Therefore, the rejection of Claims 31-33 under 35 U.S.C. § 103 has been overcome.

VIII. 35 U.S.C. § 103, Obviousness

Claim 34 stands rejected under 35 U.S.C. § 103 as being unpatentable over Brisson (U.S. Patent No. 5,678,052) and Collier et al. (U.S. Patent No. 5,815,152) as applied to claim 25, hereinafter “Collier” and in further view of Official Notice. This rejection is respectfully traversed.

Applicants have cancelled Claim 34 herewith, without prejudice or disclaimer.

Therefore, the rejection of Claim 34 under 35 U.S.C. § 103 has been overcome.

IX. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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